

**REMARKS**

**I. STATUS OF THE CLAIMS**

Claims 1, 5-8, 13, 14, and 18-32 are pending in this Application. No claim is amended herein.

Applicants acknowledge and appreciate that the Examiner has withdrawn the finality of the previous Office Action. Applicants further acknowledge and appreciate that the Examiner has withdrawn the Section 103(a) rejection of claims 1, 4-8, 13, 14 and 18-32 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 4,340,519 to Kotera et al. ("*Kotera*") in view of U.S. Patent No. 6,139,958 to Raghupathi et al. ("*Raghupathi*").

**II. REJECTION UNDER 35 U.S.C. § 102**

The Examiner has rejected claims 1, 5-7, 13, 14, 18-21, 23-27, 29, and 30 under 35 U.S.C. § 102(b) as anticipated by U.S. Pat. No. 5,527,838 to Afzali-Ardakani et al. ("*Afzali-Ardakani*") for the reasons disclosed at pages 2-4 of the present Office Action. Applicants respectfully traverse this rejection for at least the reasons presented below.

A rejection under Section 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (C.C.P.A. 1972). "For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly." M.P.E.P. § 706.02. The identical invention must be described in as complete detail as is contained in, and must be arranged as required by, the claim. M.P.E.P. § 2131. Indeed, in order to anticipate the claimed invention, a reference must "clearly and unequivocally disclose

the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing and combining various disclosures.” *In re Arkley*, 455 F.2d at 587. Importantly, the absence of a single element or limitation indicates the reference neither describes nor anticipates the claim. M.P.E.P. § 2131.

*Afzali-Ardakani* fails to expressly or inherently teach a fabric comprising at least one strand comprising a plurality of fibers and having a resin compatible powdered coating composition on at least a portion of a surface of the fabric, the resin compatible powdered coating composition comprising, *inter alia*, a plurality of discrete particles, at least one lubricious material different from the plurality of discrete particles, and at least one film-forming material, wherein the at least one fiber strand comprises at least one glass fiber.

*Afzali-Ardakani* discloses a curable material comprising a particulate filler and a blend of fluorine-containing cyanate and a fluorine-containing arylene ether polymer. See, e.g., *Afzali-Ardakani*, abstract and claim 1. Applicants respectfully submit that the Examiner has failed to show that *Afzali-Ardakani* discloses (1) at least one lubricious material different from the plurality of discrete particles and (2) a resin compatible coating composition.

The Examiner cites a “fluorine-containing polymer” as anticipating the lubricious material in the present invention. Office Action mailed June 16, 2005, at 3. An examination of the specification of *Afzali-Ardakani*, however, reveals that a fluorine-containing thermoplastic polymer is defined as a “modifier” which dissolves in a disclosed resin and subsequently “undergoes an in-situ phase separation process

during cure to form a microphone-separated multiphase thermoset material.” *Afzali-Ardakani*, col. 1, lines 11-20 and col. 2, lines 35-37. There is no mention of the use of such a polymer as a lubricant.

Additionally, nothing in *Afzali-Ardakani* supports the Examiner's conclusion that the resin material disclosed in the reference is a coating composition. Indeed, a close examination of *Afzali-Ardakani* reveals that the resin cited by the Examiner is used to impregnate various types of materials and, therefore, is not a “coating composition on at least a portion of a *surface* of the fabric.” See, e.g., *Afzali-Ardakani*, col. 1, lines 23-27; col. 13, lines 35-37; see *also* present specification, claim 1 (emphasis added). Such a use does not teach or suggest that the resin is utilized as a coating.

Applicants therefore respectfully submit the rejections are improper and request that the Examiner withdraw the Section 102(b) rejection of independent claim 1 over *Afzali-Ardakani*, and dependent claims 5-7, 13, 14, 18-21, 23-27, 29, and 30 that depend therefrom.

### **III. REJECTION UNDER 35 U.S.C. § 103**

The Examiner has rejected claims 1, 5, 13, 14, and 18-32 under 35 U.S.C. § 103(a) as unpatentable over U.S. Pat. No. 4,340,519 to Kotera et al. (“*Kotera*”) in view of U.S. Pat. No. 6,346,160 B1 to Puppini (“*Puppini*”). Applicants respectfully traverse this rejection for at least the reasons that follow.

To establish a *prima facie* case of obviousness over a combination of references, the Examiner “bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” *Cf. In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Specifically, the

Examiner must prove such a desire to combine references with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002). The Federal Circuit has on numerous occasions stated that to establish a prima facie case of obviousness an Examiner must show that the references, taken alone or in combination, (1) teach all the present claim limitations; (2) would have suggested to or provided motivation for one of ordinary skill in the art to make the claimed invention; and (3) would have provided one of ordinary skill with a reasonable expectation of success in so making. See *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (citing *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988)). “Both the suggestion and the reasonable expectation of success must be found in the prior art reference, not in the applicant’s disclosure.” *In re Vaeck* at 1442 (emphasis added).

In the present case, Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness because the Examiner has not shown that *Kotera* and *Puppini*, in combination, meet all of the aforementioned requirements. See M.P.E.P. §§2143.01, 2143.02, & 2143.03.

1. The Rejection Should Be Reversed Because Neither The Prior Art Nor The Knowledge Generally Available To One Of Ordinary Skill In The Art Provides The Requisite Suggestion Or Motivation To Combine *Kotera* And *Puppini*

The Federal Circuit has noted that the Examiner’s burden to establish a motivation to combine or modify is provided by an objective teaching found in the prior art. The Examiner’s factual findings regarding the motivation to combine or modify must

be “clear and particular.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). The Examiner fails to set forth such “clear and particular” evidence here.

a        *The Examiner’s Failure To Present Evidence Of Motivation  
Dictates Dismissal Of The Examiner’s Rejection*

Although the Examiner claims that, when combined, *Kotera* and *Puppín* disclose the present invention, the Examiner failed to make the requisite factual inquiry based on the objective evidence of record. Such an inquiry reveals that there is no motivation to make the proposed combinations at the time the invention was made for at least the following reasons.

**First**, *Kotera* is drawn to preparing an aqueous dispersion of polyester resin, comprising a crystalline polyester, a non-crystalline polyester, a water-soluble organic compound and water. See *Kotera* at Abstract. *Puppín*, on the other hand, is drawn to a composite material, comprising a thermoplastic resin and a glass fabric, used in the form of a linear extrudate as a structural member or as a repair unit. See *Puppín* at Abstract and Summary of Invention.

**Second**, as discussed in the response and request for reconsideration to the Final Office Action mailed April 26, 2004, and incorporated by reference herein in full, *Kotera* teaches that the resin gives an *external* coating layer. See, e.g., *Kotera* at Abstract and col. 2, lines 9-12. The resin in *Puppín*, however, is utilized to “intimately” contact and wet the fabric, whereby the “resin is incorporated *into* the fabric.” *Puppín*, col. 4, lines 49-53 (emphasis added).

**Third**, *Kotera* is drawn to preparing a resin dispersion to externally treat plastic and glass products, such as “horticultural house, materials for window, lens, or the like.” *Kotera*, col. 9, lines 45-47. Such a coating provides the coated products with excellent water resistance and weatherability. See *Kotera* at Abstract and col. 2, lines 9-12. *Puppin*, on the other hand, is drawn to a process which creates reinforcement composites. See *Puppin*, col. 1, lines 30-34. Such composites are not coatings, instead serving as “a direct substitute for the equivalent structural member milled shape in a wood or metal structural member.” *Id.*, col. 2, lines 60-63; see also col. 3, lines 9-13.

*Kotera* and *Puppin* are therefore directed to the use of **different** chemicals in **different** methods for **different** purposes to obtain **different** products. Applicants therefore submit that one of ordinary skill in the art reading these two references would not have been motivated to combine their divergent teachings as proposed by the Examiner. Accordingly, for at least this reason, Applicants submit that the Examiner has failed to demonstrate a prima facie case of obviousness.

b. *The References Teach Away From The Examiner's Proposed Combination*

It is well-settled that claims are not obvious if the cited reference or other relevant art teaches away from the claimed invention. M.P.E.P. § 2145(X)(D)(1).

In the present case, *Kotera* and *Puppin* expressly teach away from their combination. Central to the invention disclosed in *Kotera* is a polyester resin that is utilized “for various utilities such as coating compositions, laminated products, aqueous

printing ink, aqueous binder for coating, and surface treating agent for giving drip-proof.” *Kotera*, col. 2, lines 15-20. Indeed, *Kotera* expressly teaches that the resin gives “a coating film having excellent water resistance and excellent weatherability.” See, e.g., *id.*, col. 1, lines 7-8; col. 2, lines 11-15; col 7, lines 47-48. The potential uses of the polyester resin disclosed in *Kotera* and all the Examples found in *Kotera* further support this fact. Such language clearly indicates that the resin acts as an external coating for a finished object.

An examination of the entire disclosure in *Puppín*, however, leads one of skill in the art away from a combination with *Kotera*. As discussed above, *Puppín* expressly teaches to the “use of a thermoplastic resin and continuous glass fiber fabric material wherein the fabric is intimately contacted and *wetted* by the resin and organic materials.” *Puppín*, col. 4, lines 49-52. *Puppín* further states that the resin is *incorporated into* the fabric.” *Id.* Therefore, the glass fabric is embedded within the resin material, with little or no contact to any external surfaces. See, e.g., *id.* at col. 5, lines 9-16 (“[A]ny pore, crevice, crack, passage way, indentation, etc., in the warp and weft is fully filled by thermoplastic [resin] material.”). As a result, the composite materials taught in *Puppín* serve as substitutes for solid structural materials such as wood or metal. *Id.*, col. 2, lines 60-63 and col. 3, lines 8-13.

Such a teaching would clearly lead one skilled in the art away from the combination of *Puppín* with *Kotera*, where the claimed polyester resin is utilized on external surfaces. For at least this reason, the teachings of *Kotera* and *Puppín* cannot be combined in the manner proposed by the Examiner.

2. There Is No Evidence Of A Reasonable Expectation Of Success

In addition to showing a motivation to modify/combine the prior art references to make the claimed invention, the Examiner must show why a person of ordinary skill in the art would have had a reasonable expectation of success for such a modification/combination. See, e.g., M.P.E.P. §2143.02.

In the present case, the Examiner has not presented evidence that the teachings of *Kotera* and *Puppini* would have provided one of ordinary skill in the art with a reasonable expectation of success in making the present invention. Rather, the Examiner states that given the teachings of *Kotera* and *Puppini*, one of ordinary skill in the art would have “the reasonable expectation of obtaining a window having a good coefficient of thermal expansion, high tensile strength and high modulus.” Office Action mailed June 16, 2005, at 5. Since the Examiner has not provided *any* justification or support for such an expectation beyond the statement itself, Applicants submit that the Examiner has failed in the duty to adequately show reasonable expectation of success.

As a result, Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness, and as a result, has not met the burden for establishing obviousness. Applicants respectfully request that the Section 103 rejection of claims 1, 5, 13, 14, and 18-32 be withdrawn.

**IV. DOUBLE PATENTING**

Claims 1, 5-8, 13, 14, and 18-32 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 5-8, 13, 14, 18-32, 44, 46, 47, and 50 of co-pending Application No. 09/620,526.



Without acquiescing to or agreeing with the Examiner's characterization of the claims, Applicants respectfully request that this rejection be held in abeyance until such time as this application or the other rejected co-pending application is otherwise in condition for allowance.

**V. CONCLUSION**

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: October 17, 2005

By: 

Mark D. Sweet  
Reg. No. 41,469